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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/800,339  | 03/12/2004  | James W. Voegele     | END-5241            | 9931             |
| 27777   | 7590        | 01/24/2006           | EXAMINER            |                  |
| PHILIP S. JOHNSON<br>JOHNSON & JOHNSON<br>ONE JOHNSON & JOHNSON PLAZA<br>NEW BRUNSWICK, NJ 08933-7003 |             |                      | ROY, ANURADHA       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3736                |                  |

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/800,339 | <b>Applicant(s)</b><br>VOEGELE, JAMES W. |  |
|                              | <b>Examiner</b><br>Anuradha Roy      | <b>Art Unit</b><br>3736                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/12/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Restrictions

- I. Claims 1-7, drawn to a biopsy device with hollow sleeve.
- II. Claims 8-14, drawn to a biopsy device with a handle, piercer, and electrode.
- III. Claims 15-10, drawn to a method of performing of performing a medical procedure.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus, as claimed in Claim 1, can be use as an articulating ionizable gas coagulator.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination in Claim 1 does not require the particulars of the handle or the piercer in Claim 8. The subcombinations

have separate utility. The handle could be used to grip a wide range of medical devices and a piercer could be used to pierce the top of a collection vial.

During a telephone conversation with Gerry Gressel on January 18, 2006 a provisional election was made with traverse to prosecute the invention of Group I, Claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Burbank et al. (US Patent No. 6,689,071). Burbank et al. discloses a biopsy device comprising:

a hollow sleeve (112 or 140) adapted to receive a tissue piercing element therein, the sleeve comprising a proximal end (225), a distal end (122), and a tissue receiving opening (148 to proximal end of 122) disposed intermediate the proximal

end and the distal end; and at least one electrode (126) disposed on the sleeve.

Regarding claims 2 & 3, Burbank et al. also discloses a biopsy device, wherein the sleeve has an open distal end (abstract) and at least one electrode (142) is associated with the tissue receiving opening (Figure 5 & 148).

In regards to claims 4 & 5, Burbank et al. further discloses a biopsy device comprising at least two electrodes (126 & 142) and wherein the first (126) and second (142) electrodes are associated with the edges of the tissue receiving opening (Figure 5).

Regarding claim 6, Burbank et al. discloses a sleeve comprising a connector (231 & 227 to 210 & 220, respectively) for releasably attaching the sleeve to a biopsy device (Claim 8).

With regard to claim 7, Burbank et al. discloses a biopsy device wherein the at least one electrode (142) is operatively connected to a source of electrical energy (106 & Column 8, lines 1-3).

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eggers et al. (US Publication No. 2002/0019596) and Burbank et al. (US Publication No. 2003/0144605 and 2005/0090762) both disclose a biopsy device


with outer hollow sleeve and electrodes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
MAX E. HINDENBURG  
SENIOR PATENT EXAMINER  
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